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10/770,352

02/02/2004

Carl E. Whitcomb

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05/04/2006

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EXAMINER

NGUYEN, SON T

ART UNIT

PAPER NUMBER

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**MAILED**  
**MAY 04 2006**  
**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/770,352  
Filing Date: February 02, 2004  
Appellant(s): WHITCOMB, CARL E.

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Jeffrey Streets  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/15/06 appealing from the Office action  
mailed 7/26/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

10/075096

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

3080680	REYNOLDS ET AL.	4-1959
6202348	REIGER	3-2001

Art Unit: 3643

5311700	THOMAS	5-1994
5852896	FLASCH, JR.	12-1998
GB2073567A	BERLIT	10-1981
EP300578A3	VAN DER GOORBERGH	1-1989
6505440B1	LAI	1-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention. .

**Claims 1-40,46-50** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the root tips (34) are trapped or give up control in the material (18) because as best understood based on the characteristic of roots, the roots will grow in the material (18) and hit or reach material (16) and then continue to grow along the vertical sidewall not just stop at material (18). Appellant's specification did not clearly explain what prevents the root tips to just stop in the material (18) and not continue to re-route along the sidewall.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4,7,11,12,20,26,27,37-40,46** are rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds et al. (US 3080680).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5,6,8,9,14-16,24,32,33,36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above).

**Claims 10,13,17-19,47-50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Reiger (US 6202348).

**Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Thomas (US 5311700).

**Claims 22,23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Berlitz et al. (GB 2073567).

**Claims 25,29,31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Van der Goorbergh (EP 300578A3).

Art Unit: 3643

**Claims 28,34,35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Flasch, Jr. (US 5852896).

**Claim 30** is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. as modified by Berlitz et al. as applied to claims 1,3,22 above, and further in view of Flasch (as above).

#### **(10) Response to Argument**

**Appellant argued that it is necessary to review Appellant's specification for implied definitions of the claim term "root-tip-trapping". In addition, Appellant argued that in Appellant's specification, para. 41, Appellant states "as a result of root tips 34 becoming trapped, the root tips 34 swell somewhat, become more thick-bodied, give up control and allow side branches 31 to grow", which further define the root-tip-trapping term. Accordingly, the tip of a root becomes trapped and cannot grow or extend any further.**

Based on the 112 rejection above, it is unclear how the root tips (34) are trapped or give up control in the material (18) because the roots will grow in the material (18) and hit or reach material (16) and then continue to grow along the vertical sidewall not just stop at material (18). Appellant's specification did not clearly explain what prevents the root tips to just stop in the material (18) and not continue to re-route along the sidewall. Since the material (18) is a porous fabric, it is very likely that the roots can force their way along the sidewall in the area between material (16) and material (18). Reynolds et al. teach in col. 5, lines 65-75, that the roots grow in the fibre pot (18), hit or reach the impenetrable sheet (60), force their way down the sidewall of the pot into the

Art Unit: 3643

space between the pot and the sheet 60, and get trapped there along the vertical sidewall. This phenomenon should be the same in Appellant's invention because such is the nature of roots. In addition, Appellant's claim language states "root-tip-trapping region", which the space between sheet 60 and pot 18 is a root tip trapping region because the roots cannot escape through the sheet 60 since it is root impenetrable as taught by Reynolds.

**Appellant argued that regarding the proper scope of the term "sidewall", the present specification consistently distinguishes between a sidewall and a bottom. Accordingly, the Appellant asserts that the specification expressly or impliedly defines a sidewall as being distinct from a bottom or bottom wall. Appellant asserts that the term "sidewall" must be interpreted as excluding a "bottom". The Examiner has made the unsupported assertion that "a bottom sidewall is also a term known in the art too". Regardless of whether this assertion is true or not, the Examiner has produced no evidence supporting this position and this is not the terminology that has been used in Appellant's claims and defined in either the present specification or the two cited prior art references discussed.**

The Examiner has included Lai (6505440) to demonstrate that a bottom sidewall is a term known in the art (see Lai, col. 2, lines 38 & 41), which Lai calls the bottom of the pot a bottom sidewall. It is also noted that Appellant's claim language states the term "comprising", which Appellant admits in para. 44 of Appellant's specification that the term "comprising" is an open ended group. Furthermore, clearly from fig. 2 of

Art Unit: 3643

Appellant's drawings that there is a bottom to this so-to-call "sidewall". In light of Appellant's specification, it is understood that the invention is not just a sidewall but a pot or container as a whole, which pot or container having a sidewall and a bottom or bottom sidewall. In any event, the claim language does state comprising so Reynolds et al. do have a sidewall, therefore, meets the claim language limitation of a sidewall. In addition, as mentioned in the final rejection and supported by the Lai reference, the bottom of Reynolds's pot can be considered bottom sidewall. Note, Lai is only cited to provide evidence as requested by Appellant. Lai is not intended to be a new reference for rejection.

**Appellant argued that Reynolds does not expressly disclose any structure that possesses the claimed characteristic of an air-root pruning region.**

Col. 6, lines 14-21 of Reynolds et al. teach perforation at the bottom portion 61, which meets the claim limitation of a porous air-root pruning region adjacent to the root-tip-trapping region. The perforations allow air to enter the pot from the bottom and hence, air pruning the roots which grow in between the sheet 60 and the pot 18. Whether Reynolds et al. intend to plunge the pot or not, it is intended use of a device (see MPEP section 2114). Page 5, para. 12 of Appellant states that the pot can be in-ground, hence, to argue that Reynolds et al.'s pot is planted into the soil, thus would not cause air root pruning because the soil covers the pot, would be a contradiction of what is taught in Appellant's own specification because if one was to plant the pot of Appellant in-ground, there would be no air root pruning either.



**Appellant argued that there is no suggestion to combine Reynolds with Reiger since there is no teaching of bonding a porous fabric layer to a root impenetrable layer.**

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Reynolds et al. teach a fiber layer (18) bonded to a root impenetrable layer (60) and Reiger teaches in the same field of endeavour, i.e. pot having two layers, a fabric inner layer and a root impenetrable outer layer, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a spun bonded, needle punched fabric selected from polyester, polypropylene and polyolefin fiber, and a woven or knitted fabric as further taught by Reiger for the porous fabric of Reynolds et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (to prevent root circulation (see Reiger's abstract)) as a matter of obvious choice.

**Appellant argued that Reiger does not disclose protuberances. Element 160 is an inner surface of a fabric liner. Reiger never uses the term protuberance.**

**Accordingly, the term protuberance is taken to mean something that thrusts outwardly from a surrounding or adjacent surface.**

As stated in col. 7, lines 59-61, Reiger's inner surface (160) contains "rough, or fuzzy surface", thus, meets the definition of protuberance as defined by Appellant. It is inherently taught in Reiger that these fuzzy surface, which can be seen in figs. 9 & 12, that it is something that thrusts from a surrounding surface.

**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

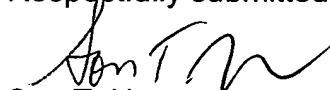
(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

Art Unit: 3643

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Son T. Nguyen', is written over the printed name.

Son T. Nguyen  
Primary Examiner  
AU 3643

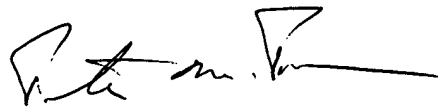
Art Unit: 3643

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

Conferees:

Peter Poon

Jeff Gellner



**PETER M. POON**  
**SUPERVISORY PATENT EXAMINER**